



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,130	09/21/2005	Takafumi Fujii	576P078	1262
42754	7590	01/10/2008	EXAMINER	
Niels & Lemack 176 E. Main Street Suite #5 Westboro, MA 01581			KLEMANSKI, HELENE G	
			ART UNIT	PAPER NUMBER
			1793	
			MAIL DATE	DELIVERY MODE
			01/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/550,130

Applicant(s)

FUJII ET AL.

Examiner

Helene Klemanski

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/12/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The references cited in the Search Report dated May 14, 2004 have been considered.

Claim Objections

2. Claims 1, 2, 4, 7, 9 and 19-21 are objected to because of the following informalities: in claim 1, the first line after Formula (1), the phrase "[in Formula (1)," should be replaced with the term "wherein"; also in claim 1, the thirteenth line after Formula (1), the period and the right bracket should be deleted; lastly in claim 1, the first line after Formula (3), ", in Formula (3)," should be replaced with the term "wherein"; in claim 2, the first line after Formula (4), ", in Formula (4)," should be replaced with the term "wherein"; in claim 4, all the left and right parentheses should be deleted; in claim 7, the first line after Formula (5), "(in Formula (5), respectively," should be replaced with the term "wherein"; and lastly in claim 5, the last line, the right parenthesis should be deleted; in claim 9, line 1, the phrase "characterized by" should be deleted; in claim 19, line 2, the phrase "characterized by" should be replaced with the term "comprising"; in claim 20, lines 1 and 2, the phrase "wherein, in the phthalocyanine colorant" should be deleted; also in claim 20, the first line after Formula (9), the left parenthesis should be deleted; lastly in claim 20, the last line, the right parenthesis and the comma should be deleted; in claim 21, the first line after Formula (10), the left parenthesis should be

deleted and lastly in claim 21, the last line, the right parenthesis should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 11-13, the terms "is used" and "using" are indefinite. A "process" defined in the sole terms of "use of" does not define patentable subject matter under 35 USC 101. See *In re Fong*, 129 U.S.P.Q. 264 (CCPA 1961). The examiner suggests incorporating defined method steps into these claims to overcome this rejection.

Claim 13 is considered confusing since it is dependent upon two different claims. The examiner suggests incorporating the ink composition as defined in claim 9 into claim 13 or incorporating the ink set according to claim 12 into claim 13 to overcome this rejection.

Claim Rejections - 35 USC § 102

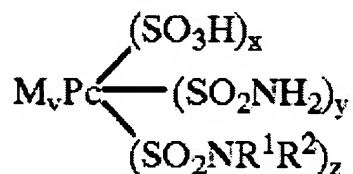
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Robertson et al. (US 6,149,722).

7. Robertson et al. teach an ink composition comprising water, an organic solvent and 0.01-30 parts by weight of one or more phthalocyanine compounds of the formula



wherein M is a metal such as Cu; Pc represents a phthalocyanine nucleus; R¹ is H; R² is -(CH₂)_nR³, or R¹ and R² together with the nitrogen atom to which they are attached represent a 5- or 6-membered ring; n is an integer of 1-30; R³ independently represents sulpho, -CO₂R⁵ or -NR⁶R⁷; R⁵ and R⁶ independently represent a C₁₋₃₀ alkyl group optionally substituted by sulpho or carboxy; v is the valence of Pc divided by the valence of M; x is from 1.2-3.8; y is from 0.1-2.7, z is from 0.1-2.7 and x, y and z satisfy 2 ≤ x+y+z ≤ 4. Robertson et al. further teach a process for printing comprising ejecting the above ink jet ink composition onto a substrate such as a coated paper. See col. 1, line 38 - col. 2, line 55, col. 5, lines 1-63, col. 7, lines 40-63, examples 3 and 4 and claims 1-5, 10 and 15-19. The phthalocyanine compounds and ink composition as taught by Robertson et al. appears to anticipate the present claims.

Conclusion

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

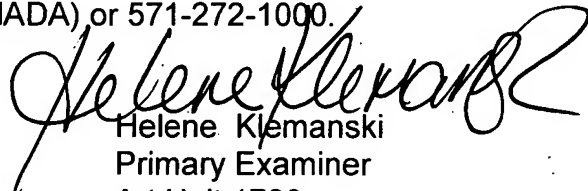
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 7:00-3:30.

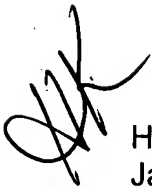
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/550,130
Art Unit: 1793

Page 6

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Helene Klemanski
Primary Examiner
Art Unit 1793



HK
January 6, 2008